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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,432	08/01/2001	John M. Cuckler	10557/247605	6380

23370 7590 08/07/2003

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EXAMINER

WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 08/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,432

Applicant(s)

CUCKLER ET AL. *cn*

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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The reissue oath/declaration filed with this application is defective because it fails to identify at least one error that is relied upon to support the reissue application (37 CFR 1.175(a)(1) and MPEP § 1414).

Claims 1-76 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above (37 CFR 1.175).

In the Information Disclosure Statement of July 8, 2002, certain references were not considered because a concise explanation of the relevance (37 C.F.R. § 1.98(a)(3)) was not presented.

The Applicant has failed to specifically point out the support in the original disclosure for each of the newly presented claims (M.P.E.P. 714.02). Although the Applicant refers to the figures and to column 2, line 20, through column 3, line 6, and to column 5, lines 1-7, of the specification, a “slight ridge” (e.g., claim 47, line 11), a “partially bendable” fixation member (e.g., claim 52), and other claimed features are nowhere to be found among these cited portions of the original disclosure. Therefore, the Applicant is required to particularly point out, claim by claim, the support in the original disclosure for the claim limitations in response to the instant Office action.

Claims 1-12, 35-46, 53, and 56-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Parts (a) and (d) of claim 1 are confusing because it appears from the specification and the drawings that the annular reinforcements are positioned on the convex, proximal side rather than on the concave, distal side; reference is made to Figures 5-7, 10-11, and 16-19. Also, “proximal” is misspelled on the sixth line of claim 1. Part (f) of claim 1

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is difficult to comprehend. Claim 11 contains a grammatical error. In claim 35, part (d), “the distal surface” lacks a proper antecedent basis. In claims 35-46, use of the terms “flange portion” and “flange” interchangeably creates confusion; claim 40 is especially confusing because it apparently suggests the possibility of only one flange, whereas claim 35 calls for a plurality of flange portions (claim 35, part (c)). In claim 53, “the diameter” lacks a proper antecedent basis. In claim 56, it is not clear whether the “at least one fixation member” appearing on line 5 is the same as that appearing on line 8. Regarding claim 66, lines 4-5, how can the fixation members be a part of the cup body and yet *extend from* the cup body? It appears that these should be claimed as distinct (though perhaps integral) elements of the prosthesis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 35, 36, 40, 41, 43-49, 51-59, and 61-65 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Adyasov et al., RU 2 021 786 C1, which discloses a metal cup member **1** with a rim plane defined by the edge at which the circumferential buttress angles inwardly from the rim so as to support or contain the insert **2** (Figures 1 and 2). The figures also illustrate a plurality of circumferentially spaced, radially extending flange portions **4**. Regarding claims 47 and 56, the circumferential buttress is certainly *capable* of at least partially containing flow of securing material, whether or not there was the intent to use such securing material (which is not a positively recited element of claim 47).

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adyasov et al., RU 2 021 786 C1. Regarding claim 38, each flange portion extending about 20 degrees around the cup member would have been obvious from Figure 2 and in order to ensure reliable retention of the implanted components (last three lines of the Derwent abstract).

Claims 1-13 and 35-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capello, US 5,702,477, which includes a cup body **20**, a liner **18**, an annular rim **28**, a cement mantle **92**, and a peripheral buttress portion **50**. Capello apparently teaches only one annularly reinforced opening **80** (Figures 1, 4, and 5; column 3, lines 59-67), but more than one in the buttress portion **50** and/or in the branches **42** and **44** would have been obvious in order to

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improve the fixation of the buttress portion **50** and/or to facilitate the conforming of the branches **42** and **44** to the bone (column 3, lines 35-38). Regarding claim 8, a slot, well known in the art, would have been obvious in order, for example, to provide an engagement means for a surgical tool. Regarding claims 10, 11, and others, the buttress can alternatively be interpreted as the supplemental support web **60**.

Claims 35-44, 56, 58-66, and 76 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Zichner et al., US 5,425,778. Regarding claim 35, a rim and a rim plane are defined by the supporting ring **1** (Figures 1 and 3), and the buttress **4** extends distally downwardly from said plane (Figure 3). Regarding claim 37, the buttress **4** extends about 105 degrees from one end of a groove **26** to an opposed end of an adjacent groove **26** (Figure 1). Regarding claim 56 and the references to cement on lines 3 and 7, attention is directed to the note below.

Claims 45-55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zichner et al., US 5,425,778. Regarding claims 45 and 46, inferior, posterior, and superior flanges in combination were well known in the art and would have been obvious in order to improve the anchorage of the device. Regarding claim 47, holes in the cup **2** for bone screws or the like would have been obvious in order to better prevent disassembly of the prosthesis after implant by using other portions of the patient's skeletal structure for support; the containing portion is viewed as either the aforementioned rim of the ring **1** or as the portion defined by the cylindrical surface **14** of the cup **2** (column 3, lines 11-14).


Note: the "flow of securing material" (last two lines of instant claim 47), for example, is not a positively recited element. It has been held that the recitation that an element is "adapted

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to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense (*In re Hutchison*, 69 USPQ 138). MPEP 2106, section II. C., explains that language which suggests or makes optional but “does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation”; “examples of language that may raise a question as to the limiting effect of the language in a claim” are “adapted to” and “adapted for” clauses. Certainly the Zichner et al. containing portions are *capable* of partially containing flow of securing material, whether or not such was the intent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, who is available Monday through Thursday and whose telephone number is (703) 308-2903. The supervisor, Corrine McDermott, can be reached at (703) 308-2111. The receptionist’s phone number is (703) 308-0858, and the main FAX numbers are (703) 305-3591, 3590.

dhw: D. Willse
August 1, 2003


DAVE WILLSE
PRIMARY EXAMINER
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